

REMARKS

This Amendment and Response is submitted to respond to the office action dated October 28, 2005. Claims 1-28 and 30-33 are pending and stand rejected. The Examiner has rejected claims 1-28 and 30-33 as unpatentable under 35 U.S.C. Section 103 over Watanabe et al. ("Watanabe") in view of Mousseau et al. ("Mousseau et al."). Specifically, in paragraphs 4-19 of the office action, the Examiner rejects claims 1-28 and 30-33, stating that it would have been obvious for one of ordinary skill in the art to combine the two references.

Watanabe issued on February 1, 2005, and is based on a filing date of April 18, 2001, a little over a month before the filing date of the present application (May 31, 2001). Clearly, it took Applicant's counsel at the time, some time to prepare and submit the present application to the U.S. Patent & Trademark Office. In the event Applicant invented the claimed subject matter before the filing date of Watanabe, which is likely, Watanabe would not be prior art to the claims at issue here.

Nevertheless, with respect to the independent claims 1 and 27, the Examiner assumes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Watanabe with Mousseau and indicates that the motivation for such a combination "*would have been developing [a] system for pushing/notifying from a host system to user's mobile device based on the user-defined elements.*" With respect to the remaining dependent claims, the Examiner relies on the same bases for rejecting the independent claims as well as additional bases.

Applicant respectfully requests that the Examiner is only able to make such an assertion with the benefit of hindsight provided by the present application because there is no teaching in Watanabe that suggests an explicit motivation to combine the references in the manner suggested by the Examiner. To that end, Applicant respectfully points the Examiner's attention to the following case law and requests the Examiner to reconsider his rejections.

Applicant respectfully submits that the Examiner's rejection for obviousness is improper because there is nothing in the cited prior art references, either singly or in combination, to suggest the desirability of the claimed subject matter. That the construction in a particular prior art reference would have resulted in the claimed combination had it followed the "common practice" of attaching certain parts does not show obviousness at the time of the invention but rather reflects improper hindsight analysis and the reading into the art of Applicant's own teachings.

In re Raynes, 7 F.3d 1037, 1039 (Fed. Cir. 1993):

When determining whether a new combination of known elements would have been obvious in terms of 35 U.S.C. § 103, the analytic focus is upon the state of knowledge at the time the invention was made. The Commissioner bears the burden of showing that such knowledge provided some teaching, suggestion, or motivation to make the particular combination that was made by the applicant. *In re Oetiker*, 977 F.2d 1443, 1445-47, 24 U.S.P.Q.2D (BNA) 1443, 1444-46 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. (BNA) 785, 788 (Fed. Cir. 1984). This determination is made from the viewpoint of the hypothetical person of ordinary skill in the field of the invention. 35 U.S.C. § 103; *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991).

In re Deminski, 796 F.2d 436, 442 (Fed. Cir. 1986):

"There was no suggestion in the prior art to provide Deminski with the motivation to design the valve assembly so that it would be removable as a unit. The board argues that if Pocock had followed the "common practice" of attaching the valve stem to the valve structure, then the valve assembly would be removable as a unit. The only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art Deminski's own teachings. Hindsight analysis is clearly improper, since the statutory test is whether "the subject matter as a whole would have been obvious at the time the invention was made." 35 U.S.C. § 103 (1982); *In re Sponnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 585, 160 U.S.P.Q. (BNA) 237, 243 (CCPA 1969)."

Applicant respectfully requests the Examiner reconsider all the outstanding rejections based on the arguments urged here and to withdraw them. The Examiner is invited to telephone the undersigned representative if an interview might be useful for any reason.

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Respectfully submitted,

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